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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,265	08/18/2003	James Edward Angelo	50103-566	1518
49745	7590	09/15/2006	EXAMINER	
SEAGATE TECHNOLOGY LLC c/o MCDERMOTT WILL & EMERY LLP 600 13TH STREET, NW WASHINGTON, DC 20005-3096			FALASCO, LOUIS V	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,265

Applicant(s)

ANGELO ET AL.

Examiner

Louis Falasco

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/18/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Papers Received

1. The Information Disclosure Statement filed 08/18/03 is acknowledged.
2. The Election filed 08/30/06 is acknowledged.

Claims

3. The claims are: 11-20.

Election/Restriction of Invention

4. Claims 11-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention. Election was made **without** traverse in the reply filed on 08/30/06.
5. The claims under consideration are: 19 and 20.

Claim Rejections - 35 U.S.C. §102 and 35 U.S.C. §103 Statutory Basis

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Rejections

6. Claims 19 and 20 are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over any of: **Conder et al** (US 4105292), **Neudeck** (US 6461003) or **Chen et al** (US 6497925).

Conder et al, **Neudeck** and **Chen et al** all teach the embossment stamper of these claims, except an intention as for producing 'landing' and 'data' zone embossments.

Conder et al teaches an embossing stamper, intended for embossing a recording medium, including a stamper comprised of a body with spaced-apart projection zones - illustrated at Fig. 4 and at Fig. 2 having body 8 and embossments 12, also see col. 3 lns 39-41. The embossing means includes a pattern detailed at col. 1 ln 64 to col. 2 ln 4, col. 3 lns 2-7, lns 56-59, col. 4 lns 8, 9.

Neudeck teaches an embossing stamper including a stamper body projections, this includes spaced-apart projected zones - illustrated as item 20 at Figs. 1 and 2

and as item 120a at Fig. 3. The stamper is comprised of a body having a surface for embossing a pattern of recesses, see col. 6 lns 53 to 65, col. 7 lns 19-21.

Chen et al teaches an embossing stamper for magnetic recording medium having an embossing zone pattern detailed at col. 3, lns 3 and 31; col. 4 lns 2,3; "EXAMPLES" section at col. 5 lns 52-54.

As regard intended use of the stamper for the servo, 'landing' and 'data' zone in the preamble and claim body: all of **Conder et al**, **Neudeck** and **Chen et al** teach the stamper with dimensions for embossments within what is required to form the servo, 'landing' and 'data' zones – cf instant specification page 11 lines 24-29 with **Conder et al** col. 3 lns 2-7, lns 56-59, col. 4 lns 8, 9; with **Neudeck** col. 7 lns 45-47, col. 8 lns 65-68 and col. 9 lns 31-33 and with **Conder et al** col. 3 lns 2-7, lns 56-59, col. 4 lns 8, 9. Thus all of **Conder et al**, **Neudeck** and **Chen et al** inherently have the characteristic property required to form servo, 'landing' and 'data' zones. The claiming of a property unidentified in the prior art but appearing inherently present does not necessarily make a claim patentable, a case of anticipation or prima facie obviousness has been established the burden of proof shifts to applicant to show prior art products do not necessarily nor inherently possess the characteristic of the claimed product - see In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

CONCLUSION

The claims are 11 to 20. Only claims 19 and 20 are under consideration


- No claim has been allowed.
- Information Disclosure Statement has been received.

INQUIRES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco, PhD whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney, PhD can be reached at (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LF
09/06

CAROL CHANEY
SUPERVISORY PATENT EXAMINER

